

SEP 18 2007

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Application No.: 10/787,343

Inventor(s): Culeron *et al.*

Filed: February 26, 2004

Docket No.: AA-615M3

Confirmation No.: 3968

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- 1) Response to Notice of Non-Compliant Appeal Brief – 15 Pages

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/787,343
Inventor(s) : Guy Hubert Stephane Sylvain Culeron *et al.*
Filed : February 26, 2004
Art Unit : 1751
Examiner : Lorna M. Douyon
Docket No. : AA-615M3
Confirmation No. : 3968
Customer No. : 27752
Title : FOAM-GENERATING KIT CONTAINING A FOAM-
GENERATING DISPENSER AND A COMPOSITION
CONTAINING A HIGH LEVEL OF SURFACTANT

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

This is in response to the Notification of Non-Compliant Appeal Brief mailed August 20, 2007. The following is the original Appeal Brief filed on July 20, 2007, with corrections requested. This original Appeal Brief of July 20, 2007, was filed pursuant to the appeal from the decision communicated in the Office Action mailed on February 20, 2007.

A timely Notice of Appeal was filed on May 21, 2007.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences or judicial proceedings.

STATUS OF CLAIMS

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Claims 1 – 9, and 11-15 are rejected under 35 U.S.C. § 103(a) over U.S Patent No. 5,075,026 to Loth et al.

Claims 1 to 6, 9, and 14 to 15 are appealed.

A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

STATUS OF AMENDMENTS

No amendment was filed.

SUMMARY OF CLAIMED SUBJECT MATTER

The only independent claim in the application is Claim 1. Claim 1 is directed to a foam-generating kit comprising a non-aerosol container comprising a foam-generating dispenser for generating a foam (see page 4, line 15 to page 7, line 19 of the substitute specification submitted July 14, 2004, hereinafter “the specification”; and Fig. 1); and a high surfactant dishwashing composition (see page 7, line 21 to page 15, line 18 of the specification) comprising at least about 20 wt. % of a surfactant system (see page 14, lines 11 – 15). The dishwashing composition further comprises at least one of a microemulsion and a protomicroemulsion (see page 15, lines 13 to 18; and page 17, lines 7 – 28 of the specification). When employed with the high surfactant composition, the foam-generating dispenser generates a foam having a foam to weight ratio of greater than about 2 mL/g (see page 5, lines 27 to 32 and page 21, lines 1 – 27 of the specification).

Claim 2 depends from Claim 1, and is further directed to a high surfactant composition which comprises from about 30 wt. % to about 99 wt. % surfactant system. See page 14, lines 11-15 of the specification.

Claim 3 depends from Claim 1, and is further directed to a foam-generating dispenser having at least three meshes, wherein the high surfactant composition flows through the three meshes in a series so as to generate the foam. See page 6, lines 15 – 22.

Claim 4 depends from Claim 1, and is further directed to a high surfactant composition which is a Newtonian Fluid. See page 14, lines 23 to 31 of the specification.

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Claim 5 depends from Claim 1, and is further directed to a high surfactant composition comprising an enzyme. See page 7, lines 26 to 30; and page 14, line 32 to page 15, line 12 of the specification.

Claim 6 depends from Claim 1, and is further directed to a kit including a shaped applicator. See page 18, line 5 to page 20, line 3 of the specification; Fig. 2; and Fig. 3.

Claim 9 depends from Claim 1, and is further directed to a foam-generating dispenser comprising a sponge. See page 6, lines 23 to 32 of the specification.

Claim 14 depends from Claim 1, and is further directed to a microemulsion or protomicroemulsion comprising a low water-soluble oil having a solubility in water of less than about 5,000 ppm. See page 15, lines 13 to 18 of the specification.

Claim 15 depends from Claim 14, and is further directed to a low water-soluble oil selected from the group consisting of terpenes, isoparaffins, and mixtures thereof. See page 15, lines 13 to 18 of the specification.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 – 2, 4, 6 – 8, and 11-15 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,075,026 to Loth et al.

Claim 3 is rejected under 35 U.S.C. § 103(a) over Loth et al. in view of U.S. Patent No. 5,635,469 to Fowler et al.

Claim 5 is rejected under 35 U.S.C. § 103(a) over Loth et al. in view of U.S. Patent No. 5,679,630 to Baeck et al.

Claim 9 is rejected under 35 U.S.C. § 103(a) over Loth et al. in view of U.S. Patent No. 3,422,993 to Boehm et al.

ARGUMENT

Applicants wish for the Board to address the issue of whether the Office may recharacterize claim limitations without explicit rationale. It is Applicants' position that the Office may not recharacterize claim limitations.

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The Claims require a foam-generating dispenser and a high-surfactant composition which, when employed together, produce a foam of a minimum foam-to-weight ratio.

Claim 1 is drawn to a foam-generating kit comprising a foam-generating dispenser and a high surfactant dishwashing composition, wherein the foam-generating dispenser generates a foam having a foam to weight ratio of greater than about 2mL/g when employed with the high surfactant composition. All other appealed claims depend, directly or indirectly, from Claim 1, and therefore include these claim elements.

The Office Action of June 13, 2006 cites Loth et al. for a pump-type sprayer.

The Office Action of June 13, 2006 cites Loth et al. as teaching that "liquid compositions can be packaged under pressure in an aerosol container or in a pump-type sprayer." Page 4 (emphasis in original). The Office Action goes on to clarify that Loth et al. "fails to disclose a dispenser which generates a foam having a foam to weight ratio greater than about 2ml/g." Page 4.

The Office Action then reasons that the claimed foam-to-weight ratio would be expected in the disclosure of Loth et al. because "similar ingredients" and a "similar dispenser" are disclosed. In response, Applicants submitted a declaration under 37 C.F.R. § 1.132 ("the Ortiz Declaration") showing that placing a high surfactant dishwashing composition in a typical pump-type sprayer does not produce a foam having a foam-to-weight ratio greater than about 2mL/g.

The Office Action of February 20, 2007 denies that Loth et al. describes a pump-type sprayer in a meaningful way.

The Office Action of February 20, 2007 addressed the Ortiz Declaration by stating that "none of these sprayers are identified or specifically disclosed in Loth to make a meaningful side-by-side comparison." Page 3. Applicants submit that it cannot be

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obvious to use the pump-type sprayer of Loth as a foam-generating dispenser if the pump-type sprayer of Loth is not sufficiently described so as to determine the structure or function of the sprayer. Without an enabling disclosure, the reference is not available as prior art. MPEP § 2121.01. Merely naming or describing the subject matter is insufficient if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 U.S.P.Q.2d 1373, 1376 (Fed. Cir. 2003).

The Office Action of February 20, 2007 does not address the claim limitations.

The Office Action of February 20, 2007 only makes sense if the claims are read to require a pump-type sprayer rather than a foam-generating dispenser. Otherwise, the Office Action of June 13, 2006 provides that 1) the claim limitations directed to foam density are not disclosed in Loth et al.; and the Office Action of February 20, 2007 provides that 2) Loth et al. does not provide sufficient detail about the disclosed pump-type sprayer to infer a specific structure or function.

In effect, the Office Action of February 20, 2007 reads limitations out of the claims, replacing them with terms found in the references cited. This is not a simple case of rewording the claim limitation, but one of recharacterizing or even ignoring a claim limitation in order to apply vague references to an allegedly similar structure. This is impermissible. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03. See also *In re Kuhn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006) (identification of each claim element in the prior art is necessary, but not sufficient, to defeat patentability).

Applicants respectfully request reversal of the rejections based on Loth et al. as failing to disclose all claim limitations.

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Applicants further request that the Board address the issue of Whether the Office may discount a declaration under 37 C.F.R. § 1.132 without adequately explaining why the declaration is unpersuasive. It is Applicants' position that the Office may not discount a declaration under 37 C.F.R. § 1.132 without adequately explaining why the declaration is unpersuasive.

The Office Action reasons for discounting the Ortiz Declaration are flawed.

The Office Action of February 20, 2007 addressed the Ortiz Declaration by stating that Loth does not specifically disclose a pump-type sprayer, preventing a "meaningful side-by-side comparison." Page 3. This ground is addressed above.

The Office Action of February 20, 2007 also argues that the Ortiz Declaration is ineffective because "the showing is not commensurate in scope with the claims." Page 3. Applicants can find no authority for the requirement that a declaration, submitted to refute an unsupported allegation of similarity to a cited reference, provide data commensurate in scope with the claims.

The Office Action of February 20, 2007 further alleges that the Ortiz Declaration is flawed because it "did not specify which formulation was exactly used for the showing," and because "it is not clear whether the same formulation is used for the tests" reported. Pages 3 - 4. As demonstrated below, these objections are overwrought. When Applicants traverse a rejection, the Office is required to reconsider all of the evidence, without prejudice.

A determination of obviousness is a legal conclusion which must be supported by substantial evidence. *In re Zurko*, 258 F.3d 1379, 1384, 59 U.S.P.Q.2d 1693, 1696 (Fed. Cir. 2001). Substantial evidence requires that the "Board must point to some concrete evidence in the record in support of [fact] findings." *In re Zurko*, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697. When using facts so found to support a determination of

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obviousness, the written record must further document the logic which leads from the facts to the rejection. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ___, 14 (2007) (quoting *In re Kahn*, 442 F.3d at 988, 78 U.S.P.Q.2d at 1336 (Fed. Cir. 2006)).

“If rebuttal evidence of adequate weight is produced, the holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. Regardless of whether the *prima facie* case could have been characterized as strong or weak, the examiner must consider all of the evidence anew.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Even if the initially presented case for *prima facie* obviousness is taken as compelling, the production of evidence requires reassessment of “all the evidence and should not be influenced by any earlier conclusions.” MPEP § 2144.08(III) (citing to *In re Piasecki*, 745 F.2d at 1472-73, 223 U.S.P.Q. at 788). “[T]he nature of the matter sought to be established, as well as the strength of the opposing evidence, must be taken into consideration in assessing the probative value of expert opinion.” *In re Oelrich*, 579 F.2d 86, 91, 198 USPQ 210, 215 (CCPA 1978). “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP § 2144.03C. *See also* 37 C.F.R. § 1.104(d)(2).

The Office Action inaccurately suggests that the Ortiz Declaration is flawed.

The Ortiz Declaration need not present data commensurate in scope with the claims.

The Office Action of February 20, 2007 alleges that the Ortiz Declaration is defunct because “the showing is not commensurate in scope with the claims.” Page 4.

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Applicants submit that the Ortiz Declaration was intended to refute the allegation of the Office Action that "similar" compositions in "similar" dispensers would yield the claimed foam-to-weight ratio. See Applicant's Remarks submitted November 13, 2006 at Page 5 ("In the event one of skill in the art would equate a pump-type sprayer with a foam-generating dispenser, as shown by the testing data presented in Dr. Ortiz's declaration, the foam to weight ratio is not within the limits in the present claims."). Therefore the Ortiz Declaration is not subject to the requirement that declarations to establish surprising results must provide data commensurate in scope with the claims.

The Ortiz Declaration is sufficiently clear about the test methodology.

The Office Action of February 20, 2007 alleges that the Ortiz Declaration is defunct because "Applicants allege that the compositions similar to those discussed in the present application . . . were used but did not specify which formulation was exactly used." Page 3. Further, the Office Action of February 20, 2007 states, "it is not clear whether the same formulation is used for the tests." Pages 3 - 4.

The descriptions of the test performed are adequate in light of the intended purpose of the declaration. The composition used was consistent with the exemplary embodiments described in the specification. Further, although Applicants regret any lack of clarity, the consistent use of singular forms and comparative terms strongly suggest that the same composition was used in generating data from each of the two dispensers tested. For example, the Ortiz Declaration explains that "the" composition, when used in a pump-type sprayer "versus" a foam-generating dispenser, "does not" generate the foam to weight ratio claimed in the present application. Ortiz Declaration at ¶5.

Applicants submit that the description of the test performed is adequate in light of the Office Action's vague assertions of "similar" dispensers. More detailed and more thorough testing would not be any more convincing in the absence of a more structured

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framework for the rejection. Specifically, no amount of data will overcome the speculation that *some* kind of pump-type sprayer *might* satisfy the claim limitations.

The Office Action fails to fully and accurately explain why the declaration is unpersuasive.

As described above, the alleged failings of the Ortiz Declaration are inapt or overstated. The Ortiz Declaration is therefore the only evidence of record as to the meaning of the disclosure of Loth et al. to one of skill in the art. As the only evidence of record, the Ortiz Declaration presents a strong case for allowance of the pending claims.

Conclusion: The Office Action fails to present and sustain a *prima facie* case of obviousness.

As the Federal Circuit has explained:

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument.

In re Glaug, 283 F.3d 1335, 1338, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002).

Applicants have shown that no *prima facie* case for obviousness has been established. Applicants have further shown that even if the arguments on record are taken to constitute a *prima facie* case for obviousness, the references, logical reasoning, and assumptions on

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which the case for obviousness rest have all been adequately traversed. Applicants respectfully request reconsideration and allowance of the pending claims.

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Respectfully submitted,
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CLAIMS APPENDIX

1. A foam-generating kit comprising:
 - A. a non-aerosol container comprising a foam-generating dispenser for generating a foam; and
 - B. a high surfactant dishwashing composition comprising, by weight of the high surfactant composition, at least about 20% of a surfactant system, said dishwashing composition comprising at least one of a microemulsion and a protomicroemulsion,wherein when employed with the high surfactant composition, the foam-generating dispenser generates a foam having a foam to weight ratio of greater than about 2 mL/g.
2. The foam-generating kit according to Claim 1, wherein said surfactant system comprises from about 30% to about 99% of the high surfactant dishwashing composition, by weight.
3. The foam-generating kit according to Claim 1, wherein the foam-generating dispenser comprises at least three meshes, wherein the high surfactant composition flows through the three meshes in series so as to generate the foam.
4. The foam-generating kit according to Claim 1, wherein the high surfactant composition is a Newtonian Fluid.
5. The foam-generating kit according to Claim 1, wherein the high surfactant composition further comprises an enzyme.
6. The foam-generating kit according to Claim 1, further comprising a shaped applicator.
9. The foam-generating kit of Claim 1, wherein the foam-generating dispenser comprises a sponge.
14. The foam-generating kit according to Claim 1 wherein the microemulsion or protomicroemulsion comprises a low water-soluble oil having a solubility in water of less than about 5,000 ppm.

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15. The foam-generating kit according to Claim 14 wherein the low water-soluble oil is selected from the group consisting of: terpenes, isoparaffins, and mixtures thereof.

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EVIDENCE APPENDIX

A. US Patent No. 5,075,026 to Loth et al.

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RELATED PROCEEDINGS APPENDIX

None.